

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRUCE M. DICKENS

Appeal No. 2007-0952

Application No. 09/512,592

Reexamination Control Nos. 90/005,592, 90/005,628,
90/005,727, and 90/006,541



ORDER REMANDING APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on November 1, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are the Appeal Brief and the Examiner's Answer as identified further below.

Appeal Brief

A review of the file indicates that the appeal brief filed December 12, 2005, has used the format set forth in 37 CFR § 1.192(c). However, 37 CFR § 1.192 was abolished on September 13, 2004, and replaced by 37 CFR § 41.37(c). Accordingly, the appeal brief filed on December 12, 2005, does not comply with 37 CFR § 41.37(c).

37 CFR § 41.37(c) states:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review.

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or

of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix*. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

A review of the application indicates that the following appropriate headings are missing from the Appeal Brief filed December 12, 2005:

- 1) “Summary of the Claimed Subject Matter” is set forth in
37 CFR § 41.37(c)(1)(v);
- 2) “Grounds of Rejection to be Reviewed on Appeal” as set forth in
37 CFR § 41.37(c)(1)(vi);
- 3) “Evidence Appendix” as set forth in
37 CFR § 41.37(c)(1)(ix); and
- 4) “Related Proceedings Appendix” as set forth in
37 CFR § 41.37(c)(1)(x).

Furthermore, separate headings for “Issues,” “Summary of the Invention,” and “Grouping of Claims” have been discontinued. Comments regarding whether claims are to be argued separately or as a group need to be contained under the heading for “Argument.”

Accordingly, the Appeal Brief filed on December 12, 2005, does not comply with the new rules under 37 CFR § 41.37(c). It is required that a corrected appeal brief be submitted that is in compliance with 37 CFR § 41.37(c). For more

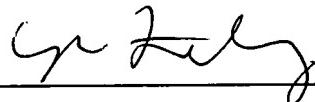
information on the new rules see the web page entitled More Information on the Rules of Practice Before the BPAI, Final Rule,
<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

- 1) instruct Appellants to provide a corrected appeal brief which fully complies with 37 C.F.R. § 41.37(c);
- 2) have said corrected appeal brief made a part of the IFW Official record; and
- 3) either acknowledge entry and consideration of the corrected appeal brief or submit an amended examiner's answer if needed; and
- 4) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES



CRAIG FEINBERG
DEPUTY CHIEF TRIAL ADMINISTRATOR
(571) 272-9797

cc (via First Class Mail):

Bruce Dickens
Dickens-Soeder 2000 LLC
3892 Cedron Street
Irvine, CA 92606

Paul E. Crawford
Connolly Bove Loge and Hutz LLP
1200 Market Street
Wilmington, DE 19801

Stanley B. Green
Connolly Bove Loge and Hutz LLP
1990 M. Street, NW
Washington, DC 20012

Ross F. Hunt, Jr.
Larson and Taylor
1199 North Fairfax Street
Suite 900
Alexandria, VA 22314